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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,946

04/13/2004

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P18836

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10/09/2009

EXAMINER

SHEPARD, JUSTIN E

ART UNIT

PAPER NUMBER

2424

MAIL DATE

DELIVERY MODE

10/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,946	<b>Applicant(s)</b> JUTZI, CURTIS E.	
	<b>Examiner</b> Justin E. Shepard	<b>Art Unit</b> 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, see Amendment, filed 9/2/09, with respect to the rejection(s) of claim(s) 1, 4, 7, 10, 13, and 16 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ellis, Arad and Silver.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The published specification (paragraph 16) states that the computer readable medium could be a signal or a wave, both of which do not meet the statutory requirement. The examiner suggests that the applicant remove this portion of the paragraph (leaving the tangible mediums such as CD-ROMs, ROMs, etc.) to make the computer readable medium claims fit into a statutory category.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 7, 10, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Arad in view of Silver.

Referring to claim 1, Ellis discloses a method, comprising:

determining a channel to which a television was reserved to be watched by a user (paragraph 61, lines 18-21; figure 1(a), part 118);

determining whether the reserved channel was a tuned via a set-top box (paragraph 59, lines 6-12; figure 5, parts 504 and 114; paragraph 61, lines 18-21; Note: the VCR recording the output of tuner 504 is interpreted as the program being tuned by the STB);

if the reserved channel was tuned via a STB, then sending a signal to the set-top box to indicate that the television is on line with the reserved channel (paragraph 61, lines 18-21);

if a tuner in the set-top box is not available for the television, then receiving an indication from the set-top box, the indication identifying a cable channel that was reserved for transmission on the STB for the television (paragraph 61, lines 18-21); and

automatically changing the television to the identified cable channel to satisfy expectations of a user when the tuner is not available for the television (paragraph 61, lines 18-21).

Ellis does not disclose a method wherein the reserved channel is the last channel the user was watching before the television was shut off; and

wherein the channel provided via the set-top box is a radio frequency remodulated (RF-remodulated) channel.

In an analogous art, Arad teaches a method wherein the channel provided via the set-top box is a radio frequency remodulated (RF-remodulated) channel (paragraph 9).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the remodulating taught by Arad to the method disclosed by Ellis. The motivation would have been to allow the VCR to record scrambled shows such as HBO by having the STB tune to them and then modulate them onto a channel the VCR can tune to (Ellis: paragraph 59, lines 18-23; page 4, paragraph 41, lines 4-7).

Ellis and Arad do not disclose a method wherein the reserved channel is the last channel the user was watching before the television was shut off.

In an analogous art, Silver teaches a method wherein the reserved channel is the last channel the user was watching before the television was shut off (column 4, lines 29-35).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the last channel recall taught by Silver to the method disclosed by Ellis and Arad. The motivation would have been to enable the user to not need to search for the previous channel they were watching, thereby eliminating delay experienced by the user.

Claims 4, 7, 10, 13, and 16 are rejected on the same grounds as claim 1.

Claims 2, 3, 5, 6, 8, 9, 11, 12, 14, 15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis, Arad and Silver as applied to the claims above, and further in view of Bates.

Referring to claim 2, Ellis discloses a method of claim 1, further comprising: receiving a channel change command using a programming guide (paragraph 61, lines 18-21).

Ellis, Arad and Silver do not disclose a method wherein the channel change command is a channel up signal; and changing the television to an adjacent cable channel one above the cable channel.

In an analogous art, Bates teaches a method wherein the channel change command is a channel up signal; and changing the television to an adjacent cable channel one above the cable channel (column 6, lines 18-28).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to substitute the EPG channel change with the channel up/down command taught by Bates as the combination would have yielded predictable results.

Claims 5, 8, 11, 14, and 17 are rejected on the same grounds as claim 2.

Referring to claim 3, Ellis discloses a method of claim 1, further comprising: receiving a channel change command using a programming guide (paragraph 61, lines 18-21).

Ellis, Arad and Silver do not disclose a method wherein the channel change command is a channel down signal; and changing the television to an adjacent cable channel one below the cable channel.

In an analogous art, Bates teaches a method wherein the channel change command is a channel down signal; and changing the television to an adjacent cable channel one below the cable channel (column 6, lines 18-28).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to substitute the EPG channel change with the channel up/down command taught by Bates as the combination would have yielded predictable results.

Claims 6, 9, 12, 15 and 18 are rejected on the same grounds as claim 3.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-5967.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/  
Supervisory Patent Examiner, Art  
Unit 2424

JS